



Docket No.: 1075.1183

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kazuhiro AKUTSU et al.

Serial No. 09/993,616

Group Art Unit: 3691

Confirmation No. 8236

Filed: November 27, 2001

Examiner: John O. Preston

For: ATM PLACEMENT FEE DETERMINATION METHOD, SERVICE PROVIDING SYSTEM, FINANCING SYSTEM, AUTOMATED TRANSACTION MACHINE, AUTOMATED FINANCIAL TRANSACTION MACHINE, AND RECORDING MEDIUM IN WHICH ATM PLACEMENT FEE DETERMINATION PROGRAM IS RECORDED

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and the requisite fee.

If there are any additional fees associated with filing of this Request, please charge the same to our Deposit Account No. 19-3935.

REMARKS

Claims 1-9, 11-19, and 26-33 are pending and under consideration in the application. Claims 1, 26-27, 29, and 31-33 are the independent claims.

A pre-appeal brief panel review of the identified appealable issue I discussed below is requested.

I. The cited prior art, alone or in combination, does not teach all of the recited features of the claims

In the final Office Action mailed November 9, 2010, independent claims 1, 26-27, 29, and 31-33 were rejected under 35 U.S.C. 103(a), as being unpatentable over Atlas ATM website, hereinafter "Atlas", in view of U.S. Patent 6,195,694 to Chen et al., hereinafter, "Chen 694" and in view of U.S. Patent App. Pub. No. 2002/0032656 of Chen et al., hereinafter, "Chen 656".

Independent claim 1, for example, recites:

obtaining, by the server computer, when it is determined that the financial institution that issued the credit card used is identical to the service provider that installed the ATM, electronic history information of the ATM, the electronic history information of the ATM consisting of beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents; and

determining, by the server computer, the ATM placement fee, which is to be paid to the fee recipient entity, in a computer-implemented way based on said obtained electronic history information.

It is respectfully submitted that these features of claim 1 are not taught by Atlas, Chen 694, or Chen 656 and, therefore, claim 1 patentably distinguishes over the combination.

In rejecting claim 1, the Examiner indicates that Chen 694 discloses that "the operator of the kiosk receives payment from a service provider, such as a bank, when a user operates the kiosk to perform a web browsing function the benefits the service provider, and wherein the payment may be based on the time or duration that the information is provided by the kiosk (Chen '694: column 6 lines 45-55)." This is submitted to be incorrect.

Chen 694, in col. 6, lines 45-65 states:

The selection functions 105A, and/or other information displayed, also can be a source of revenue for the owner/operator of the kiosk. For example, notices provided by the kiosk can be advertisements made for a fee. Application providers (e.g. banks, mutual funds, mortgage companies, lenders, brokers (stock, real

estate), rental businesses (cars, equipment), services providers, and retailers) would pay a fee to have a selection function 105A on the kiosk 100/200 that the user would select to configure the kiosk to their application. The amount of the fee might be based on: the location of the kiosk, the position/location of the selection function/information on the kiosk (e.g. graphical user interface), the size of the selection function 105A, **the time and duration that the selection function 105A/information is provided by the kiosk**, etc. The selection functions 105A/information can be changed at different times or displayed periodically in order to target a different class of customers/clients. For instance, a kiosk in Grand Central Station might have commuter information **displayed at rush hour** and would be reconfigured to have selection functions 105A for restaurant reservations just before lunch time.

Thus, Chen 694 merely discloses that the amount of the fee might be based on time and duration that the selection function 105A/information is provided by the kiosk, etc. Chen, as relied on by the Examiner, merely discloses paying a fee to the owner of a kiosk based on how long a selection function, such as an icon 105A, is displayed to a user of the kiosk. As an example, Chen 694 mentions that a bigger fee might be in order if the kiosk was placed in Grand Central Station at rush hour. However, the time and duration that the selection function 105A/information is provided by the kiosk does not correspond to the claimed beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents, as recited in claim 1, for example. Chen makes no mention of browsing web contents on the Internet and basing the fee on such beneficial browsing.

As such, Chen 694 does not disclose “obtaining ... electronic history information of the ATM, the electronic history information of the ATM consisting of beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents” and “determining the ATM placement fee, which is to be paid to the fee recipient entity, in a computer-implemented way based on said obtained electronic history information,” as recited in claim 1. Neither Atlas nor Chen 656 makes up for this deficiency in Chen 694.

Furthermore, as mentioned above, claim 1 provides for obtaining electronic history of the ATM that consists of beneficial browsing that provides benefits to the financial institution as the service provider on the Internet as a result of browsing of the web contents. Chen 694, in col. 6, merely discloses that “the selection functions 105A, and/or other information displayed, also can be a source of revenue for the owner/operator of the kiosk. For example, notices provided by the

kiosk can be advertisements made for a fee. Application providers (e.g. banks, mutual funds, mortgage companies, lenders, brokers (stock, real estate), rental businesses (cars, equipment), services providers, and retailers) would pay a fee to have a selection function 105A on the kiosk 100/200 that the user would select to configure the kiosk to their application.” As such, the bank providing the application is different from the installer of the kiosk. Thus, in Chen 694, displaying the selection function 105A/information is beneficial to the bank and not the installer of the kiosk.

Furthermore, in rejecting claim 1, the Examiner indicates that Chen 656 “teaches levying a surcharge to a user of an ATM if the card used to perform the transaction was not issued by the service provider that installed the ATM.” However, Chen 656 merely discloses that “a fee charged to the consumer for the convenience of using an ATM owned by any entity other than the consumer's financial institution.” Thus, Chen 656 does not disclose determining an ATM placement fee as recited in claim 1, for example. Neither Atlas nor Chen 694 makes up for this deficiency in Chen 656.

Since the cited references, alone or in combination, do not discuss or suggest all of the features of claim 1, claim 1 patentably distinguishes over the cited references. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 2-9, 11-19, and 26 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon (including U.S. Patent 6,672,505 to Steinmetz, which fails to make up for the deficiencies in the combination of the cited references noted above). Therefore, claims 2-9, 11-19, and 26 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

Independent claims 27, 29, and 31-33 include features similar to those discussed above with respect to claim 1. Therefore, claims 27, 29, and 31-33 patentably distinguish over the cited references for at least the reasons discussed above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

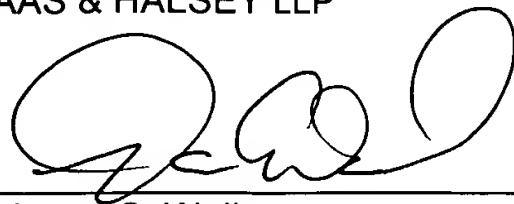
Claims 28 and 30 depend from claims 27 and 29, respectively, and include all the features of claims 27 and 29, respectively, plus additional features that are not discussed or suggested by the references relied upon (including U.S. Patent 6,672,505 to Steinmetz, which fails to make up for the deficiencies in the combination of the cited references noted above). Therefore, claims 28 and 30 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

If there are any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

Respectfully submitted,

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Date: 5-10-10

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